

REMARKS

This submission accompanies Applicants' RCE. Claims 1 – 12, 14 – 33, 35 – 44, and 46 – 57 are pending, of which claims 1 – 12, 14 – 33, 35 – 44, and 46 – 57 stand rejected. Applicants have amended claims 1, 2, 5, 11 – 12, 15 – 23, 26, 32 – 33, 35 – 36, 39, 41, 43 – 44, 46 – 47, 50, and 56 – 57. Claims 3 – 4, 8, 24 – 25, 29, 37 – 38, 40, 48 – 49, and 53 have been cancelled. All amendments are fully supported by the originally filed Specification. No new matter has been added. Applicants respectfully request the Examiner to enter all of the proposed amendments.

In view of the following discussion, Applicants believe that all of the claims are allowable. It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

REJECTIONS

35 U.S.C. §103

Claims 1 – 12, 14 – 33, 35 – 44, and 46 – 57

The Examiner has rejected claims 1 – 12, 14 – 33, 35 – 44, and 46 – 57 under 35 U.S.C. §103(a) as being unpatentable over Herz, U.S. Patent No. 6,029,195 (hereinafter "Herz") in view of Rooney U.S. Patent No, 6,819,669 (hereinafter "Rooney"). Applicants respectfully traverse the rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2141. Establishing a *prima facie* case of obviousness begins with first resolving the factual inquiries of Graham v. John Deere Co. 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the Graham factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.

Moreover, to establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all elements of the subject claim. *In re Wada*, 2007-3733 (BPAI Jan. 14, 2008) (citing, *CMFT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed.Cir. 2003)). According to MPEP §2143.03: “All words in a claim must be considered in judging the patentability of that claim against the prior art” (quoting, *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

Here, Herz and Rooney, alone or in any permissible combination, fail to teach or suggest all the elements of Applicants’ independent claim 1. More specifically, the combination of Herz and Rooney suggested by the Examiner does not teach or suggest at least:

“identifying ... conditions surrounding each of the identified activities of the current user, including amount of time the current user participated in each of the identified activities;
accessing a first collection of data comprising data associated with ...
conditions surrounding the cumulative activities of the other users,
including amount of time that each other user participated in each
respective activity,”

as recited independent claim 1 (emphasis added). In the Final Office Action, the Examiner suggests that these elements are taught by Herz in column 4, lines 39 – 43 (see Final Office Action, page 4, arguments with respect to former claim 2). Applicants respectfully disagree.

In particular, the cited portion of Herz merely suggests that the system described by Herz “enables a user to access target objects ... without requiring the user to expend an excessive amount of time and energy.” In other words, Herz suggests that the disclosed system allows the user to find the target objects fast, without, for example, spending a lot of time searching for such objects. However, whether the user can promptly access to an object (e.g., find a particular web site) is entirely different from for how long the user uses the object (e.g., browsing the web site). The Herz disclosure is completely silent with respect to the latter. Accordingly, Herz fails to teach or suggest identifying amount of time the current user participated in an activity, and thus, does not teach or suggest all the elements of Applicants’ claim 1.

Rooney fails to bridge the substantial gap between the Herz disclosure and Applicants' claimed invention. Rather, Rooney merely discloses a set top box 104 provided for allowing the user to interact with a program shown on the television set 102 (see Rooney, col. 3, lines 64 – 606). However, Rooney does not teach or suggest the above recited limitation of claim 1.

Accordingly, Herz and Rooney, alone or in combination do not disclose all the elements of claim 1. As such, Applicants respectfully submit that independent claims 1 is allowable under 35 U.S.C. §103 over Herz in view of Rooney. Independent claims 17, 22, 35, and 46 recite limitations similar to the limitations of claim 1 discussed above. Therefore, for at least the reasons discussed above, claims 17, 22, 35, and 46 are also allowable under 35 U.S.C. §103 over Herz in view of Rooney.

Furthermore, each of the dependent claims depends, either directly or indirectly, from independent claims 1, 17, 22, 35, and 46 and recites additional limitations thereof. Therefore, at least for the same reasons as discussed above, Applicants submit that each such dependent claim is also non-obvious over Herz in view of Rooney, and thus allowable under 35 U.S.C. § 103.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection.

CONCLUSION

Thus, Applicants respectfully submit that all of the claims are allowable. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 842-8110 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: _____

1/13/09

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